

"RESPONSE UNDER 37 CFR 1.11(e)  
EXPEDITED PROCEDURE EXAMINING  
GROUP 1723

Docket No.: 209991US0

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/884,084

Applicants: Kensaku KOMATSU, et al.

Filing Date: June 20, 2001

For: POROUS HOLLOW FIBER MEMBRANES AND  
METHOD OF MAKING THE SAME

Group Art Unit: 1723

Examiner: A. FORTUNA

SIR:

Attached hereto for filing are the following papers:

**SUPPLEMENTAL AMENDMENT AND REQUEST FOR  
RECONSIDERATION W/MARKED-UP COPY & ATTACHMENTS**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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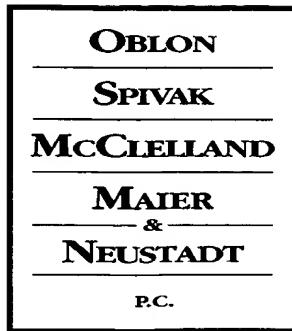


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DOCKET NO.: 209991US0

RESPONSE UNDER 37 CFR 1.11,  
EXAMINER PROCEDURE EXAMINING  
GROUP 1723

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

IN RE APPLICATION OF:

Kensaku KOMATSU, et al.

: GROUP ART UNIT: 1723

SERIAL NO.: 09/884,084

:

FILED: JUNE 20, 2001

: EXAMINER: FORTUNA, ANA M.

FOR: POROUS HOLLOW FIBER MEMBRANES AND METHOD OF MAKING THE SAME

**REQUEST FOR RECONSIDERATION**

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

In response to the Office Action dated November 22, 2002, please reconsider the application in view of the following amendment and remarks.

**REQUEST FOR RECONSIDERATION**

Claims 1-30 will are active in this application. Claims 6-28 stand withdrawn from further consideration as being drawn to non-elected subject matter.

Applicants respectfully request reconsideration of the application in view of the following remarks.

The present invention as set forth in Claim 1 relates to a porous hollow fiber membrane obtained by a method comprising preparing a spinning dope containing microparticles; forming said hollow fiber membrane from said spinning dope according to a dry-wet spinning method or a wet spinning method to obtain a spun hollow fiber membrane; and extracting and removing said microparticles by immersing said spun hollow fiber

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membrane into an extracting solution;

wherein said hollow fiber membrane has a permselectivity; wherein a particle cutoff is within the range of 1 to 10  $\mu\text{m}$ ; and wherein a pure water permeate flow is equal to or higher than 30,000 L/m<sup>2</sup>/hr/100kPa.

Applicants wish to thank Examiner Fortuna for her helpful and courteous discussion with Applicants' Representative on February 4, 2003. During this discussion it was noted that the **newly cited** references, Parham et al and Stengaard, neither disclose nor suggest the claimed membrane having a **particle cutoff of 1 to 10 $\mu\text{m}$**  or the claimed **water permeate flow**. In fact, Parham et al disclose a membrane having a pore diameter of **about 0.1 to about 0.7 microns** (Parham et al, col. 7, lines 49 and 50) which is much smaller than the claimed particle cutoff of **1 to 10 $\mu\text{m}$** . There is no suggestion or motivation to go to a higher pore size as this would be detrimental to the filtration capability of the membrane for LDL cholesterol. In addition, the term "microporous" in Parham et al does not refer to pores of 0.02 to 10 microns as argued by the Examiner. Parham et al have chosen a specific pores size so that LDL cholesterol can be filtered from whole blood. Parham et al state at col. 7, lines 41-50 as follows:

"The dimensional and porosity characteristics of the membranes of this invention are such that **LDL-C can pass through the fiber wall but most blood cells do not**. Hemolysis occurs if numerous blood cells pass through the fibers, **which is highly undesirable.....** Generally speaking, membranes can be prepared which possess a pore diameter of between about 0.1 microns to about 0.7 microns, preferably between 0.4 and 0.65 microns."

Thus, Parham et al clearly teach away from larger pore sizes as they would lead to undesirable hemolysis. In addition, since the membrane of Parham et al does not have the claimed pore size it **cannot have the claimed water permeate flow**. This is further shown by Comparison Example 2 at page 33 of the specification. Here a membrane with a particle

cutoff of **0.85 micron** was prepared. The corresponding pure water permeate flow is only **22,000 L/m<sup>2</sup>/hr/100kPa**, which is much lower than the **claimed** pure water permeate flow of **30,000 L/m<sup>2</sup>/hr/100kPa**. A smaller pore size such as disclosed in Parham et al would yield an even smaller pure water permeate flow.

Stengaard does not cure these defects because it also fails to disclose or suggest the claimed membrane having a particle cutoff of 1 to 10 $\mu\text{m}$  or the claimed water permeate flow.

Therefore, the rejection of Claims 1-4, 6-8, 29 and 30 under 35 U.S.C. §103(a) over Parham et al and the rejection of Claims 5 and 9 under 35 U.S.C. §103(a) over Parham et al in view of Stengaard is believed to be unsustainable as the present invention is neither anticipated nor obvious and withdrawal of this rejection is respectfully requested.

With respect to the Restriction Requirement, Applicants appreciate that the Examiner is considering Claims 6-9, 29 and 30 together with Claims 1-5. Applicants also appreciate the indication of a rejoinder of Claims 10-28 after allowability of the above Claims has been determined.

In addition, Applicants appreciate that the Examiner has sent signed copies of all IDS filed in this application by facsimile on December 20, 2002. However, with respect to the Form PTO-1449 of March 6, 2002, it appears on the facsimile copy that the second reference (U.S. 5,976,433) has not been initialed. Thus, Applicants respectfully request that the Examiner sends another copy of **Form PTO-1449 of March 6, 2002**, in which the second reference has been initialed as well.

Applicants submit that the present application is now in condition for allowance and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
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